

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

DAVID SCOTT WISHART et al.

Application No.: 10/615,416

Filed: July 7, 2003

For: AUTOMATIC IDENTIFICATION
OF COMPOUNDS IN A SAMPLE
MIXTURE BY MEANS OF NMR
SPECTROSCOPY

Customer No.: 20350

Confirmation No. 7969

Examiner: WHALEY, PABLOS

Technology Center/Art Unit: 1631

**RESPONSE TO RESTRICTION /
ELECTION REQUIREMENT**

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Restriction and/or Election Requirement mailed November 14, 2006, Applicants elect the claims of Group I consisting of claims 51-61 with traverse for prosecution.

The Examiner has requested restriction to one of two inventions identified by respective groups I and II of claims. Group I is said to comprise claims 51-61 drawn to a computer implemented method for producing a trace file and group II is said to comprise claims 62-64 drawn to a computer implemented process signal and apparatus for producing a trace file.

Applicant respectfully disagrees with the Examiner's grouping of the claims.

While the method of claim 51, for example, could be practiced on a device other than the apparatus claimed in claim 63 for example, it should be noted that claim 63 is essentially an apparatus version of claim 51, in means plus function language and thus is so closely related to the subject matter of the method claim, it would be reasonable to assume that a search for the

apparatus would be included when searching for the method. In other words, a proper search for the method claim should necessarily include a search for the apparatus claim and therefore no undue search burden should exist by considering the method and apparatus claims at the same time. Therefore it is respectfully submitted that the restriction requirement is improper.

Should the Examiner be unpersuaded by the above argument, Applicants hereby elect the subject matter of Group I (method claims 51-61), subject to the remarks below.

The Examiner suggested that if Group I is elected "the below summarized species elections are also required". This is not understood by the Applicants, as there does not appear to be any species indications anywhere in the office action.

The Examiner has made some remarks about requiring restriction between product and process claims, but these remarks are also not understood. As best understood, it appears the Examiner regards claim 62 reciting a computer readable medium and claim 64 reciting a signal as product claims, but the Examiner did not include these in Group I. Hence applicant cannot understand the rejection.

However, if the Examiner considers the subject matter of claims 51-61 to be considered a separate group, the Applicants request that the Examiner also regard claims 62 and 64 in the same group because claim 62, for example, recites a computer readable medium for providing codes for directing a processor circuit to execute the method of claim 51, and claim 64, for example recites a signal for causing a processor circuit to produce a trace file, the signal including codes for directing the processor circuit to execute the method of claim 51. Therefore claims 62 and 64 are merely embodiments of different physical entities that may provide functional descriptive code for causing a processor circuit to execute the method of claim 51. Therefore if the method of claim 51 is found to be patentable, so should the subject matter of claims 62 and 64. Hence claims 62 and 64 should be included in Group I.